Agilent Docket No. 10991394-5

In the United States Patent and Trademark Office
Board of Patent Appeals and Interferences

In re Application of

Inventor: Perbost

Title: BIOPOLYMER ARRAYS AND THEIR FABRICATION

Serial No.: 09/895,050

Filed: 06/29/2001

Group Art Unit: 1634
Examiner: Arun K. Chakrabarti

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Elizabeth Miller
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Hon. Commissioner for Patents
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Sir:

REPLY BRIEF

This Reply Brief is filed in response to the Examiner's Answer mailed 04/22/2003.

Respectfully submitted,

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REPLY BRIEF

Applicant responds to the items of the Examiner's Answer mailed 04/22/03 as identified below (section numbers in parentheses refer to those section numbers as used in the Examiner's Answer).

(7) Grouping of Claims

The Examiner correctly notes that the Section VIII heading of the Appeal Brief should refer to claims "29, 30, 32-35" (and not "claims 29, 20, 32-35" as referenced in the Section VIII heading). As noted by the Examiner, the body of Section VIII though correctly discusses claims 29, 30, 32-35. Applicant apologies for the typographical error in the Section VIII heading.

(10) Grounds of Rejection

The Examiner reiterates the rejection of claims 29-30, 32, and 34-35 under 35 U.S.C. 103(a) over Baldeschwieler et al. (WO 95/25116) in view of Hirschbein et al. (US 5,859,233). The Examiner agrees that Baldeschwieler et al. does not teach an apparatus wherein sufficient time is allowed for evaporation to leave solid activator at the region and then depositing the biomonomer (Page 3, 3rd full paragraph of the Examiner's Answer). However, the Examiner relies on the exact same portions of Hirschbein et al. for such a teaching as were relied upon in the Final Rejection. This rejection, including the relied upon portions of Hirschbein et al., was fully discussed and answered in Section VIII of the Appeal Brief (see specifically pages 5-8, which for brevity are not repeated here). As pointed out on those pages, Applicant's position is that the Examiner has failed in his burden to establish a *prima facie* case of obviousness for the reasons already discussed in them.

It is additionally noted though that claim 33 (for which additional reasons for patentability were provided in the Appeal Brief) is not now included in this rejection.

(11) Response to Argument

The Examiner states that Applicant incorrectly argues that because Hirschbein et al. has a preferred embodiment that it is so limited. With respect, this is a mis-characterization of Applicant's argument on pages 5-8 of the Appeal Brief. What Applicant argues is that Hirschbein et al. does not disclosure or suggest what the Examiner has alleged it does disclose or suggest.

Specifically, all the rejected claims require "(ii) allow sufficient time for evaporation to leave solid activator at the region; and (iii) then deposit the biomonomer". As pointed out in detail on pages 6 and 7 of the Appeal Brief, the only relevant disclosure in Hirschbein et al. is for using "dry reagents and solvents". However, as further pointed out on the first full paragraph of page 7 of the Appeal Brief, column 12, lines 35-39 of Hirschbein et al. make it clear that such disclosure only relates to having no water present since Hirschbein et al. defines "dry" as being "free from water":

> "A great amount of care should be exercised to use **very dry (free from water)** monomer, activator, and solvent for the coupling step and for the solvent used to wash the solid support immediately before the coupling step. (column 12, lines 35-39 of Hirschbein et al.; emphasis added)

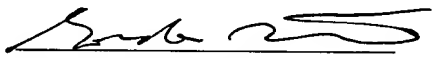
Thus, while as the Examiner points out that Hirschbein et al. does refer to the benefits of using "dry reagents and solvents" in column 13, line 46 to column 14, line 4 of that reference, this only means free from water (not somehow actually "allow sufficient time for evaporation to leave solid activator at the region; and (iii) then deposit the biomonomer" as is required by all the rejected claims).

Thus, the Examiner has not in fact pointed to any teaching or suggestion in Hirschbein et al. for the claim limitations of "(ii) allow sufficient time for evaporation to leave solid activator at the region; and (iii) then deposit the biomonomer". Accordingly,

for this reason alone the Examiner has failed to establish a *prima facie* case of obviousness and the rejection should therefore be reversed.

Furthermore, if anything, Hirschbein et al. actually teaches away from the foregoing limitations. In particular, as pointed in detail on page 7, second full paragraph of the Appeal Brief, all of Hirschbein et al.'s teachings teach that all the reactions described are in fact performed in a dry solution (free of water) of a tetrazole activator, wherein the solvent is acetonitrile. Thus, Hirschbein et al. suggests that all reactions with the activator are in fact carried out with activator in solution, contrary to the foregoing limitations of the rejected claims. Accordingly, for this additional reason this rejection should be reversed.

Respectfully submitted,



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